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8 THERMOLIFE INTERNATIONAL LLC,

9 Plaintiff,

10 v.

11 https://ronkramermusclebeach.wordpress.com/,
12 an Internet domain name;
13 https://ronkramermusclebeach.wordpress.com/
14 author/musclebeachkramer/, an Internet
15 domain name,

16 Defendants.

17 Case No. [5:15-cv-01616-HRL](#)

18
19 **ORDER GRANTING IN PART**
20 **PLAINTIFF'S MOTION FOR**
21 **ALTERNATE SERVICE**

22 Re: Dkt. No. 4

23 Plaintiff ThermoLife International LLC (ThermoLife) filed this action in rem, asserting a
24 sole claim for relief under the Anticybersquatting Consumer Protection Act (ACPA), 15 U.S.C. §
25 1125(d). ThermoLife seeks the transfer or cancellation of the registration for
26 “ronkramermusclebeach.wordpress.com” and “ronkramermusclebeach.wordpress.com/
27 author/musclebeachkramer”. These are internet blogs hosted by WordPress.com, which is owned
28 and operated by Automattic, Inc. (Automattic).

29 ThermoLife is an Arizona company that sells dietary supplements. It says that it owns
30 federally registered marks for “Muscle Beach” in connection with athletic clothing, business
31 consultation services, and health club services. Plaintiff says it also has pending trademark
32 applications for “Muscle Beach” in connection with dietary supplements and entertainment

1 services. Ron Kramer is ThermoLife's founder, President, and Chief Executive Officer.
2 According to the complaint, he is widely known in the dietary supplement industry and is
3 recognized as being affiliated with ThermoLife and the names by which it does business, such as
4 "Muscle Beach."

5 The subject blogs contain unflattering information and comments, all uploaded on April
6 23, 2014, about ThermoLife and Kramer. Plaintiff alleges that the blogs are registered and
7 authored by someone being paid by dietary supplement companies to promote dietary supplement
8 products and to disparage the Muscle Beach name and products with false and defamatory
9 information. ThermoLife says that there is no indication that the blogs currently are active
10 because no additional posts were made after the April 23 entries. (Hull Decl. ¶ 4).

11 ThermoLife moves for use of alternate service of process and a deadline by which
12 defendants must respond. Plaintiff also moves for an order waiving service by publication.

13 Upon consideration of the moving papers, this court grants in part and denies in part
14 plaintiff's motion.

15 Under the ACPA, service of process in an in rem proceeding requires a court finding that
16 the owner of a mark, despite due diligence, is unable to find a person who would have been a
17 defendant.¹ The owner satisfies due diligence by doing two things: (1) "sending a notice of the
18 alleged violation and intent to proceed [with an in rem action] to the registrant of the domain name
19 at the postal and e-mail address provided by the registrant to the registrar"; and (2) "publishing
20 notice of the action as the court may direct promptly after filing the action." 15 U.S.C. §
21 1125(d)(2)(A)(II)(aa)-(bb). These actions constitute service of process. Id. § 1125(d)(2)(B).

22 According to ThermoLife, the subject blogs contain no names or other identifying
23 information. (Hull Decl. ¶ 3). So, before filing the present lawsuit, plaintiff says it tried to
24 ascertain the identity of the blogs' author, user, or licensee by filing a civil action in Arizona state
25 court in September 2014 against a fictional John Doe defendant. In that action, ThermoLife

27 ¹ Service may also be effected where the court finds that the owner is not able to obtain in
28 personam jurisdiction over a person who would have been a defendant. 15 U.S.C. §
1125(d)(2)(A)(ii)(I). This does not apply here because, as will be discussed, ThermoLife has not
been able to ascertain the identity of any would-be defendant.

1 served Automattic with a subpoena for documents identifying the blogs' author, user, or licensee.
2 Automattic responded that it had only a single email address:
3 becausescience@anonymousspeech.com. (Hull Decl. ¶ 6). Plaintiff says this is because an email
4 address is the only personal information WordPress.com requires its users to provide when
5 establishing accounts. (Dkt. 1, Complaint ¶ 26).

6 ThermoLife says it was unable to identify the blogger based on the email address provided
7 by Automattic because AnonymousSpeech.com, the email provider, does not respond to any
8 inquiries about subscribers' emails and ignores queries about subscribers' identities. According to
9 ThermoLife, the front page of AnonymousSpeech.com's website states:

10 The most important consideration for the majority of our clientele
11 when sending anonymous secure email is his or her personal
12 anonymity. While other web-based email services will reveal your
13 identity without reservation to an interested private party with
14 money, ***AnonymousSpeech.com will not respond to inquiries made***
by foreign governments or private parties regarding the emails
sent by its subscribers. Any inquiries regarding the identity of our
subscribers are ignored. We do not respond to any of them. Our
15 servers are constantly moving in different countries (Malaysia,
16 Japan, Panama, etc.) and are always outside the US and Europe.
This is a great security advantage for our customers since it makes it
more troublesome if not impossible for any prosecutors to start a
legal dispute.

17 (Hull Decl. ¶ 7, Ex. 1) (emphasis added).

18 There being no postal address information for the subject blogger, plaintiff says that it sent
19 notice of this lawsuit to the only points of contact it has managed to find: On March 10, 2015, it
20 provided pre-litigation notice by email and postal mail to Automattic (via Automattic's counsel).
21 On April 14, about a week after the complaint was filed, ThermoLife sent notice of this suit to the
22 becausescience@anonymousspeech.com email address provided by Automattic. And, plaintiff
23 also posted notice of the complaint in the comment section of the subject blogs themselves. (Hull
24 Decl. ¶¶ 8-9).²

25
26 ² Plaintiff's counsel says that notice of discovery in the Arizona action also was uploaded on the
27 blogs' comment section and that the site claimed that the comment needed to be "moderated."
28 Counsel says that the notice appears on his computer, but does not appear when he accesses the
blogs from other IP addresses. There is, however, no indication that this also happened with the
notice of the instant lawsuit uploaded to the blogs' comment section.

1 Plaintiff now seeks a court order finding these efforts at service to be sufficient.

2 With respect to the first due diligence requirement, plaintiff did send notice to the
3 registrant's email address. Although the ACPA also requires notice to be sent to the registrant's
4 postal address, ThermoLife has established that no such address was provided to Automattic.
5 And, there is no indication that plaintiff has managed to find a postal address for anyone other
6 than Automattic. This appears to be by design, as plaintiff's motion and supporting papers
7 indicate that the registrant has taken steps to maintain anonymity. Under these circumstances, the
8 court finds that plaintiff has satisfied this first prong of due diligence. Cf. Guo v. 8bo.com, No.
9 13-cv-05299 NC, 2014 WL 2581315 at *2 (N.D. Cal., June 6, 2014) (declining to waive the postal
10 mailing requirement, even though service by postal mail was likely to be ineffective, where the
11 plaintiff had a postal address, provided by the registrant, for an intermediate registrar).

12 As for the second due diligence requirement, plaintiff "alternatively" moves to waive the
13 publication requirement, arguing that publication is entirely discretionary. Courts, however,
14 disagree whether publication is mandatory, or whether the statutory language requiring publication
15 "as the court *may* direct" gives courts discretion to waive the requirement. 15 U.S.C. §
16 1125(d)(2)(A)(ii)(II)(bb) (emphasis added). Compare Banco Inverlat, S.A. v. www.inverlat.com,
17 112 F. Supp.2d 521, 523 (E.D. Va. 2000) (concluding that "[t]he presence of the word 'may' in §
18 (bb) is properly read to mean that the publication requirement is within a court's discretion,
19 meaning that a court may or may not direct notice by publication, depending on the
20 circumstances.") with Shri Ram Mission v. Sahajmarg.org, 139 F. Supp.2d 721, 724 (E.D. Va.
21 2001) (concluding that the word "and" between § (aa) and § (bb) means that publication is
22 mandatory and that "[t]he discretion afforded by the statute to a district court is merely over the
23 manner in which notice may be published (e.g., where notice is published, how often, etc.)"). It
24 appears, however, that even when courts have waived the publication requirement, they did so
25 only where there was evidence that the registrant had actual notice of the litigation. See, e.g.,
26 Banco Inverlat, 112 F. Supp.2d at 523 (waiving the publication requirement where postal and
27 computer confirmation reports showed that the registrants received notice by postal mail and
28 opened plaintiff's email notice); Con-Way, Inc. v. CONWAYRACING.COM, No. 08-4263 SC,

1 2009 WL 2252128 (N.D. Cal., July 28, 2009) (waiving the publication requirement where the
2 registrant responded to plaintiff's notice by offering to sell the subject domain name).

3 In the present case, there is no indication that the registrant has received actual notice of
4 this suit. Thus, even assuming the publication requirement could be waived, this court would not
5 do so. Nevertheless, the court does have discretion as to the manner in which publication is to be
6 accomplished. Shri Ram Mission, 139 F. Supp.2d at 724. On this record, it is impossible to know
7 where the registrant is located, and it is anyone's guess whether the registrant is located in this
8 district, in this state, or even in this country. As discussed, this appears to be largely due to the
9 registrant's efforts to maintain anonymity. Under these circumstances, the court finds that the best
10 means of publication is via the internet to the subject blogs themselves, an action plaintiff says it
11 performed months ago.

12 The court will also require ThermoLife to complete additional online publication as
13 follows: Plaintiff shall forthwith (1) send notice of this order to the
14 becausescience@anonymousspeech.com email address; (2) post notice of this order to the subject
15 blogs, and (3) file a proof of service with the court.

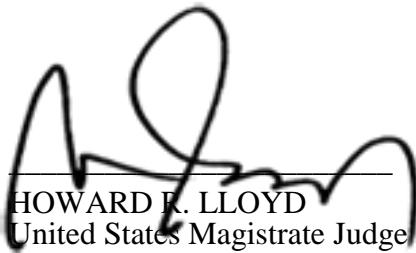
16 As an added precaution, and although the court cannot be certain how effective it would
17 be, plaintiff will also be required to publish notice of this lawsuit in a U.S. national distribution
18 newspaper. Plaintiff shall, within 14 days from the date of this order, submit to the court a
19 proposed order setting forth a procedure for publication, including proposals for a suitable
20 newspaper, length of publication, proposed language for the notice itself, and minimum size
21 requirements for the notice to be published.

22 Service of process will be deemed complete only after the additional court-ordered online
23 publication requirements are accomplished (as evidenced by the proof of service to be filed with
24 the court) and upon the last day of publication of notice in the national distribution newspaper.

1 Any response to the complaint must be filed with the court no later than 21 days thereafter.

2 SO ORDERED.

3 Dated: June 18, 2015

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10 HOWARD R. LLOYD
11 United States Magistrate Judge

United States District Court
Northern District of California

1 5:15-cv-01616-HRL Notice has been electronically mailed to:
2 Eric Blair Hull ebh@kflawaz.com, bjb@kflawaz.com, kld@kflawaz.com
3 Gregory Blain Collins gbc@kflawaz.com
4
5 Melinda Mae Morton mindy.morton@procopio.com, calendaring@procopio.com,
gail.poulos@procopio.com
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